

RITTER -- 09/530,570  
Client/Matter: 060237-0268771

REMARKS

Claims 1-5 and 7-15 are currently pending. By this Amendment, claim 1 is amended, and claims 16-30, which were previously withdrawn are cancelled. Claim 6 was previously cancelled. No new matter is added. Support for the amendment to claim 1 may be found in the specification on page 2, lines 12-13. Reconsideration in view of the above-outlined amendments and the following remarks is respectfully requested.

Entry of the Amendment is appropriate under 37 C.F.R. § 1.116 as the amendment: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not raise any new issues that would require further consideration and/or search (since the amendments amplify issues previously discussed throughout prosecution); (c) does not add any claims without canceling a corresponding number of claims; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented as it is in response to arguments raised in the Final Rejection. Entry of the Amendment is thus respectfully submitted.

Claims 1-5 and 7-15 were rejected under 35 U.S.C. 103(a) over Published PCT Application No. WO 97/40616 to Martineau et al. ("Martineau") in view of U.S Patent No. 6,657,679 to Hayes et al. ("Hayes"). This rejection is respectfully traversed.

Martineau discloses the use of smart cards for the delivery of good and services. Martineau discloses both the use of prepaid smart cards and smart cards used in connection with a prepaid card. Martineau specifically discloses a smart card and a system, which makes it possible for users to use wireless telephones anonymously. The system in Martineau permits the user to carry out payment for telephone calls without subscriptions. The expanded smart card of the telephone in Martineau is capable of cooperating with a prepaid card. The smart card is able to receive the number of remaining prepaid units from a prepaid card. If the smart card determines that there are sufficient prepaid units on the prepaid card, the smart card admits the telephone into the telephone network. The fees for any telephone calls are determined based upon a fee schedule stored in the smart card and subtracted from the prepaid card.

By contrast, amended claim 1 is directed to a billing method for billing a user for the usage of resources in a SIM card in a telecommunications network, in which the resources are not responsible for the traffic process. The billing method includes incrementing at least one counter in the SIM card when at least one of a software resource and a hardware resource is used in the SIM card. An amount to be billed is then determined from a counter value,

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provided by the at least one counter in the SIM card. The amount to be billed corresponds to at least one of a service fee and a license fee. The amount to be billed corresponding to any service fee is separately determined from the amount to be billed corresponding to any license fee. The user is then billed for at least one of the software resources and the hardware resources used in the SIM card. The amount to be billed corresponding to any service fee is separately billed from the amount to be billed corresponding to any license fee.

Martineau fails to disclose, teach or suggest the subject matter of claim 1. The Office Action correctly notes that Martineau does not disclose that the resources counted or billed are software or hardware resources on the smart card. Instead, the resource is a telephone network. Martineau also fails to disclose, teach or suggest that the amount to be billed corresponds to at least one of a service fee and a license fee. Martineau does not differentiate between fees charged. Furthermore, Martineau does not separately determine the amount to be billed corresponding to any service fee from the amount to be billed corresponding to any license fee. Martineau does not separately bill any amount corresponding to any service fee from the amount to be billed corresponding to any license fee. As such, the system disclosed by Martineau does not permit the payment of multiple parties from a single SIM card.

The Office Action relies upon Hayes for allegedly teaching the deficiencies in Martineau. Applicant respectfully disagree with this assertion. Hayes discloses a universal remote control for controlling the operation of various electronic components such as a television and VCR. The remote control 11 includes a connector 12 having a plurality of slots to permit the addition of additional electronic components such that each component can be controlled using a single remote. The remote permits the use of pay-per-view and other video functions that require payment.

Hayes, however, fails to disclose the various deficiencies of Martineau. While Hayes does permit the control of both hardware (electronic devices) and services (pay-per-view television viewing), the hardware and the services are not on the smart card. Furthermore, Hayes does not disclose, teach or suggest that the amount to be billed corresponds to at least one of a service fee and a license fee. Hayes also does not differentiate between fees charged. As such, Hayes does not separately determine the amount to be billed corresponding to any service fee from the amount to be billed corresponding to any license fee. Hayes also does not separately bill any amount corresponding to any service fee from the amount to be billed corresponding to any license fee. Accordingly, Hayes does not disclose the deficiencies in Martineau.

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Applicant respectfully submits that the combination of Martineau and Hayes does not render obvious the subject matter of claim 1. One of ordinary skill in the art would determine the claimed billing method from these references. Furthermore, one of ordinary skill in the art would not be motivated to combine these references. It would not be obvious to one of ordinary skill in the art to look to a universal remote control of television and related electronic components to modify a prepaid smart card used in connection with accessing a telecommunications network. Claim 1 is allowable over Martineau and Hayes. Claims 2-4 and 7-15 depend from claim 1 and are allowable over these references for at least the same reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

Applicant respectfully submit that the claims define subject matter that is patentable over the prior art cited of record. It is respectfully submitted that the application is in condition for allowance. Should further issues require resolution prior to allowance, the Examiner is requested to telephone applicant's undersigned attorney at the number below. Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,  
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